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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,317	10/16/2001	Tomoyuki Takeda	35.C15872	4685

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

HARVEY, DIONNE

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/977,317

Applicant(s)

TAKEDA ET AL.

Examiner

Dionne N Harvey

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/2003 and 02/2002
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 10-11 are dependent upon claim 9 and thereby encompass the limitations of claim 9. Accordingly, claims 10-11 are rejected for the same reasons set forth in the rejection of claim 9, below.

Regarding claims 9-11, In lines 7-9, the claim recites "notifying the request from the other apparatus to said returning means and a second process of notifying the request to the returning means..." The Examiner is unclear as to what is meant by "notifying the request". How is a "request" notified? What is meant by "to said returning means" Correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by **Gaulke (US 5,737,707)**.

Regarding claim 1, Gaulke teaches a pager-controlled radio telephone, reading on “an apparatus having a communication function, comprising:”;

In **column 3, lines 1-23**, Gaulke teaches an incoming-call indication, which reads on “first switching means”, and further teaches that upon receipt of an incoming call indication, the apparatus goes from a first standby state in which the apparatus awaits an incoming call (see “first stand-by mode”), to a second stand-by state in which the apparatus awaits a power turn-off indication (see “second stand-by mode”), thereby reading on “for switching between first and second stand-by modes in a stand-by state”;

In **figure 3**, Gualke teaches a switch **315**, which reads on “second switching means”, whereby when switch **315** is closed, the cellular phone is activated, thereby moving the apparatus out of pager mode (reading on a “first communication mode”) and into cellular phone mode (reading on a “second communication modes”), which reads on “second switching means for switching between first and second communication modes for the communication function”;

In **column 3, lines 12-15**, Gualke teaches that receipt of the incoming-call indication causes the interface circuitry **502** to close the switch **315**, thereby reading on “wherein switching by said first switching means and switching by said second switching means are performed in cooperation with each other.”

Regarding claim 2, In the last 5 lines of the “**ABSTRACT**”, Gualke teaches that when the cellular phone is deactivated, The battery is only used to power the pager electronics, i.e., the battery does not experience the additional drainage of powering the

Art Unit: 2643

cellular phone electronics **121**, which reads on “the first and second stand-by modes have different power consumptions.

Regarding claim 3, In **column 3, lines 11-15**, Gualke teaches that the pager device is always powered. However, once the cellular phone device is activated, the battery then powers both the pager device AND the cellular phone, thereby reading on “the first and second communication modes have different consumption powers.”

Regarding claim 4, Gualke teaches that upon receipt of the incoming call indication (“first switching means”), the switch (“second switching means”) is closed, which reads on “while switching by said second switching means is performed, switching by said first switching means is performed.”

Regarding claim 5, Gualke teaches that if while the pager controlled radiotelephone is in deactivated state, another cellular phone attempts to communicate with the pager controlled radiotelephone, the pager controlled radiotelephone switches from a pager communication mode to a radiotelephone communication mode, which reads on “wherein when the apparatus communicates with another apparatus by using the communication function, second switching means is performed.”

Regarding claim 6, Gualke teaches communication between a plurality of radiotelephone devices, thereby reading on “wherein the communication function is a wireless communication function.”

Regarding claim 12, Gaulke teaches a pager-controlled radio telephone moving between pager mode and radiotelephone mode, thereby reading on “A method of controlling an apparatus having a communication function, comprising:”;

In column 3, lines 1-23, Gaulke teaches that upon receipt of an incoming call indication, the apparatus goes from a first standby state in which the apparatus awaits an incoming call, to a second stand-by state in which the apparatus awaits a power turn-off indication, thereby reading on “a first switching step of switching between first and second stand-by modes in a stand-by state”;

In figure 3, Gualke teaches that when switch **315** is closed, the cellular phone is activated, thereby moving the apparatus out of pager mode and into cellular phone mode, which reads on “and a second switching step of switching between first and second communication modes for the communication function”;

In column 3, lines 12-15, Gualke teaches that receipt of the incoming-call indication causes the interface circuitry **502** to close the switch **315**, thereby reading on “wherein switching by said first switching means and switching by said second switching means are performed in cooperation with each other.”

Regarding claim 13, in **column 3, lines 23-43**, Gaulke teaches a processor **104**, including memory means **202**, which operates with the aid of the paging system to provide cellular-call completion for the device, thereby reading on "A storage medium storing a program for controlling an apparatus having a communication function, the program comprising:";

In **column 3, lines 1-23**, Gaulke teaches that upon receipt of an incoming call indication, the apparatus goes from a first standby state in which the apparatus awaits an incoming call, to a second stand-by state in which the apparatus awaits a power turn-off indication, thereby reading on "a first switching step of switching between first and second stand-by modes in a stand-by state";

In **figure 3**, Gualke teaches that when switch **315** is closed, the cellular phone is activated, thereby moving the apparatus out of pager mode and into cellular phone mode, which reads on "and a second switching step of switching between first and second communication modes for the communication function";

In **column 3, lines 12-15**, Gualke teaches that receipt of the incoming-call indication causes the interface circuitry **502** to close the switch **315**, thereby reading on "wherein switching by said first switching means and switching by said second switching means are performed in cooperation with each other."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Gaulke (US 5,737,707)** in view of **McCleary (US 6,622,031)**.

Regarding claim 7, Gaulke does not clearly teach that that apparatus communicates in conformity with Bluetooth specifications.

In **figure 6**, McCleary teaches a Bluetooth system and wireless communication device wherein the devices **610, 620, 630, 640** are coupled to a Bluetooth piconet, and wherein devices **610, 620, 630, 640** may be cellular phones, PDA's fax machines or the like. It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Gaulke and McCleary, altering the device of Gaulke such that it is "Bluetooth enabled", thereby permitting the user to establish a network between the personal device and other peripherals.

Regarding claim 8, in **column 7, lines 51-59**, McCleary teaches a plurality of communication modes according to Bluetooth specification, wherein the second communication mode is one of park, sniff and a hold mode.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne N Harvey whose telephone number is 703-305-1111. The examiner can normally be reached on 9-6:30 M-F and alternating Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on 703-305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. Harvey


CURTIS KUNTZ
PATENT EXAMINER
2600